

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:	)	
	)	
Christopher NUTBEEM et al.	)	Group Art Unit: 1791
	)	
Application No.: 10/511,203	)	Examiner: Mark HALPERN
	)	
Filed: October 14, 2004	)	
	)	
For: PAPER COATING PIGMENTS	)	Confirmation No. 8623

**MAIL STOP AMENDMENT**

**VIA EFS-Web**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

**RESPONSE TO RESTRICTION REQUIREMENT**

This communication responds to the Office Action mailed January 17, 2008 ("Restriction Requirement"). Claims 15-69 are pending in this application. The Office has required restriction under 35 U.S.C. § 121 and 372 to one of the following five groups of inventions.

- Group I - Claims 15-60, drawn to a pigment composition;
- Group II - Claims 61-64, drawn to a coating composition;
- Group III - Claim 65, drawn to a method of making a coating composition;
- Group IV - Claim 66, drawn to a method of making a coated gloss paper; and
- Group V - Claims 67-69, drawn to a paper.

The Office alleges that claim 15 is either anticipated by or obvious over PCT International Publication No. WO 00/66510 and, therefore, that “the special technical feature linking the inventions, precipitated calcium carbonate of aragonitic or rhombohedral morphology, kaolin clay of steepness factor greater than 20, having a shape factor of 25 or less, does not provide a contribution to the prior art, so no single general inventive concept exists.” Office Action at 2. Applicant does not agree with the Office’s conclusion and does not believe that claim 15 is either anticipated by or obvious over the cited reference. Applicant makes no substantive comments at this time regarding the patentability of the pending claims and will wait for a proper rejection, if any, of the claims before making any such comments, if necessary.

Applicant provisionally elects, with traverse, to prosecute the subject matter embodied in the claims of Group I, claims 15-60, drawn to a pigment composition.

Regarding traversal of the restriction requirement, MPEP § 803 sets forth the two criteria for a proper requirement for restriction: (1) the inventions are independent or distinct as claimed, and (2) there is a serious burden on the Examiner. Applicant submits that the Office has failed to show at least that a serious burden exists to examine all of the pending claims together. In particular, the Office has provided no reasons or evidence on the record to substantiate the restriction requirement, let alone how examination of all the claims would impose a serious burden. Applicant submits that no serious burden exists in searching the entirety of the original claims as, for instance, a proper search required for Group I would inevitably at least partially overlap a full and appropriate search required for the claims in Groups II to VI.

For at least the reasons stated above, Applicant respectfully traverses the Restriction Requirement and requests that it be withdrawn such that pending claims 27-57 be examined together during the prosecution of this application. Applicant further reserves the right to present any additional arguments regarding the restriction of the subject matter in the pending claims at any time later in this application or in any divisional or continuation applications.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: April 14, 2008

/Robert C. Stanley/  
By: \_\_\_\_\_  
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